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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023				
EXAMINER				
LAUX, JESSICA L				
ART UNIT		PAPER NUMBER		
3635				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,324

Applicant(s)

CHARLWOOD, GRANT

Examiner

JESSICA LAUX

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5/4/2009 have been fully considered but they are not persuasive.

The limitation in the claims "roll formed" is considered a product-by-process limitation. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). Even though each reference individually does not disclose the claimed invention, Belgium Patent 891445 clearly discloses a beam have the same fold structure as applicant's claimed beam (even though made by a different process) and EP 1251217 clearly discloses a beam having a seam along the third for fourth side just as applicant's claimed beam (even though made by a different process). Therefore all the structural features of applicant's claimed invention are known in the art. Therefore applicant's claimed invention unpatentable as applicant's invention is the same as or obvious from the product of the combination of prior art references, even though the prior art was made by a different process. Further applicant has not disclosed how the limitation "roll formed" imparts structural features which would distinguish applicant's invention over the prior art (applicant's remarks regarding the seam placement are not persuasive as

the prior art clearly discloses a seam placement as claimed by applicant in a product made by a process other than roll formed).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreign No. 891445 (as submitted by applicant) in view of EP 1206917 or EP 1251217 (as submitted by applicant).

Claims 1-2, 4-6, 9, and 11. 891445 discloses a beam of substantially rectangular cross-section formed from a unitary piece of metal, the beam comprising:

opposed first and second substantially parallel walls formed with at least three adjacent layers of the piece of metal (generally at 3, 4 of figures 1-2 or 5-6), where the first and second walls are smaller than the third and fourth walls, the at least three layers of the piece of metal being substantially parallel to the first and second substantially parallel walls (as seen in the figures);

wherein the three layers in the first and second walls are formed from two layers of metal spanning approximately half the width of the first and second walls and one layer spanning all of the width of the first and second walls, wherein the two half width layer form the beam exterior (figures 1, 5) or the beams interior (figures 2, 6) and

opposed third and fourth substantially parallel walls (1) between the first and second walls.

891445 does not expressly disclose one of the third or fourth walls has a seam joining two opposed longitudinal edges of the piece of metal.

EP 1206917 or EP 1251217 disclose a beam from a unitary piece of metal having first through fourth walls and further one of the third or fourth walls having a seam (4, 19 respectively) joining two opposed edges of the metal.

It should be noted that the limitation "roll formed" is considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to combine known design options within his/her technical grasp to achieve the predictable results of a beam of a unitary piece of material have multiple layers at the first and second sides and a seam closing the piece on the third or fourth side to create a structurally solid beam (where one of skill would be motivated to pursue the known options to maximize strength and minimize production/material costs so that the beam is suitable for its intended purpose, as beams are commonly used in various situations having various strength and stability requirements).

Claim 3. The beam as in claim 2 above where it is not expressly disclosed that the three layers each extend the width of the beam, but rather that one layer does and two layers extend half the width.

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the layers of 891445 to each extend the full width of the beam to increase strength and stability by reducing points of weakness (as it is well known that a discontinuous layer would have a point of weakness at the juncture, where a continuous layer would not).

Claim 10. The beam as in claim 9 above, where it is not expressly disclosed that there are three indentations in each of the third and fourth walls.

It is notoriously common and well known that additional indentations provide additionally stability and strength. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide three indentations equally spaced (to evenly distribute the strength and for manufacturing efficiency) in the third and fourth wall (where one of the indentations is formed by the seam as disclosed by EP 1206917) to create a superior beam.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreign No. 891445 (as submitted by applicant) in view of EP 1206917 or EP 1251217 (as submitted by applicant) and further in view of WO 93/15353 (as submitted by applicant).

Claim 7. The beam as claimed in claim 1 above, where it is not expressly disclosed that the beam also includes at least two adjacent layers of metal in the region of its four corners directed away from the first and second walls.

WO 93/15353 discloses a metal beam that includes multiple layers of metal at the first and second sides and additionally includes at least two adjacent layers of metal in the region of its four corners directed away from the first and second walls (figures 2,4)

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the beam of claim 1 as presented above to have multiple layers of metal at the corners to provide additional reinforcement and stability predictably resulting in a stronger beam.

Claim 8. The beam as in claim 7 above, where it is not expressly disclosed that there are three layers of metal in the region of the four corners.

However, it is notoriously common and well known that additionally layers provide additionally support, strength and stability to the product. Further it is noted that 891445 discloses three layers. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the beam of claim 7 above to have three layers of metal at the four corners to achieve a structurally superior beam capable of withstanding higher loading/forces.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/J. L./
Examiner, Art Unit 3635